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prescription information and providing access to all of (1) information about a patient's medical history, (2) information about therapeutic agents and (3) information about individual prescriber activity, wherein the information is obtained from one or more databases located remotely from a computing device running said computer program.

REMARKS

Applicants wish to thank the Examiner for the many courtesies extended to Applicants' representatives during an interview on July 16, 2001.

Claims 70, 72-92 and 94-102 remain in the application. Claims 71 and 93 have been cancelled in our January 12, 2000 Amendment. All remaining claims stand rejected.

The Examiner rejected claims 70, 72-92 and 94-102 under 35 USC 112, second paragraph as indefinite. The Examiner objected first to the last three lines of claim 70 and the last two lines of claim 99 as indefinite. The Examiner suggested that Markush type language would be recommended to solve that objection. The Examiner's suggestion has been adopted and those claims have been amended as suggested.

The Examiner also objected to claims 85, 91 and 94 and 100-102 in that the term "offsite" was "vague and confusing." The term "offsite" has been replaced with amended language to clarify any possible confusion. Accordingly, the rejection of these claims under 35 USC 112, second paragraph, should have been overcome.

The Examiner rejected claims 70, 72-83, 91, 92, 94-99 101, and 102 as anticipated by Schrier et al. The Examiner acknowledges that the computer in Schrier is connected to a network of computers "as part of a hospital or other type of clinical setting." The Examiner then goes on to say that "No patentable weight is attributable to who runs or operates the

other computers that the computer (112) communicates with, since this has no bearing on the physical structure of the system."

Applicant respectfully requests reconsideration of the Examiner's position. The Examiner cannot merely ignore claim limitations. The specific claim limitations that the Examiner chooses to ignore provide functionality, such as access to HMO formularies and insurance payment for prescriptions, that are not permitted by the system of Schrier et al. Accordingly, it is inappropriate to ignore express limitations in the claim when determining whether or not the claim is anticipated under 35 USC 102.

Claims 70 and 99 have been converted to method claims as suggested by the Examiner during the interview and require that the user computer selectively communicates "with one or more other computers run respectively by or on behalf of one or more of a group consisting of (a) the Health Maintenance Organization, (b) an insurance company, (c) a drug benefit plan, (d) a pharmacy run by a different organization than the organization running the user computer, (e) a laboratory, and (f) a physician practice." The Schrier reference does not teach or suggest any of these limitations.

Independent claim 91 addresses "compiling a patient record at a location... [by] interrogating databases located remotely from said location expected to contain information about a patient based on a patient's relationship with the provider of that database." This is neither taught nor suggested by Schrier et al.

Independent claim 94 requires a "user computer and a graphical user interface" and includes the step of "permitting capture of prescription information and selectively accessing... information about individual prescriber activity, from only databases located remotely from the location from said user computer." Schrier et al. do not describe a

graphical user interface which permits access to information about individual prescriber activity. Although it may record the fact that a particular prescriber did fill out a particular prescription, the user interface does not provide access to it as required by claim 94. Further, in Schrier, the information is not obtained from offsite databases.

Independent claim 101 requires, inter alia, "a computer program... containing instructions for interrogating databases remotely located from a computer running said computer program expected to contain information about a patient based on a patient's relationship with the provider of that database." Schrier does not teach or suggest communicating with said offsite databases and certainly not with respect to databases "expected to contain information about a patient based on a patient's relationship with the provider of that database."

Independent claim 102 requires "a computer program... for implementing a graphical user interface... providing access to... information about individual prescriber activity, wherein the information is obtained from one or more databases located remotely from a computing device running said computer program."

Thus, each of the independent claims rejected by the Examiner as anticipated by Schrier et al., contain limitations which are neither taught nor suggested by Schrier et al. Accordingly, Applicant respectfully requests that the Examiner withdraw these objections.

The Examiner rejected claims 84-90 and 100 under 35 USC 102 as unpatentable over Schrier et al. in view of Ballantyne et al. The Examiner states:

"Ballantyne et al. discloses the usage of personal digital assistants (10) as a user computer in a telemedicine environment. It would have been obvious to one of ordinary skill in the art to substitute a personal digital assistant for the user computer (112) in Schrier et al. so as to allow the user the advantage of mobility, as taught by Ballantyne et al."

There are several problems with the Examiner's analysis. First, Ballantyne does not disclose the use of "personal digital assistants." The term Ballantyne uses is "personal data assistant."

In the application under examination, the specification, beginning on page 19, line 23, recites the following:

"The prescription management system shown in this embodiment of the invention has been designed for implementation on physically compact, portable, user-interface devices, such as small portable personal computers, especially hand held devices known as personal digital assistants."

An example of a personal digital assistant is given in the specification at page 8, line 3 et seq. where the "Apple NEWTON" is referenced. The Apple Newton was a handheld device similar to the Palm™ brand of personal digital assistants that are currently popular.

The personal data assistant of Ballantyne et al. has considerably different characteristics than the "personal digital assistant" of this application. In Ballantyne et al., the "personal data assistant" is designed to "replace the paper clip board and allow the user to interface to an electronic database." See column 13, lines 40, 43 and 44. Further, the "personal data assistant" of the Ballantyne reference are maintained at the nursing station and are not personal to the individual who uses the "personal data assistant." See column 12, line 12, et seq. Like the clipboard it replaces, the "personal data assistant" of Ballantyne et al. is used by a plurality of different individuals. It is therefore quite different from the "personal digital assistant" of the application which is truly a device personal to an individual.

It is also quite clear that one could not substitute a "personal digital assistant for the user computer (112) in Schrier et al." This is because personal digital assistants, even advanced personal digital assistants, lack the computing power, by design, to implement the functionality of the user computer 112 in Schrier et al.

Finally, if one were to substitute the "personal data assistant" of Ballantyne et al. for the user computer of Schrier et al., there would be no "advantage of mobility" since the personal data assistant of Ballantyne et al. is designed to be maintained in the nurses station and not to travel with a particular individual.

For the reasons given, Applicant believes that the application is in condition for allowance and Applicant requests that the Examiner give the application favorable consideration and permit it to issue as a patent.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claims 70, 73-92, 94, and 99-102 have been amended as follows:

70. (Thrice Amended) A method of using a computerized prescription system, [comprising] having

at least one user computer[, said user computer having] and a graphical user interface, the method comprising the steps of:

a. permitting capture of prescription information and

b. selectively providing access to all of (1) information about a patient's prescription history, (2) information about pharmaceuticals arranged by medical conditions for which the pharmaceuticals are suitable for treating, and (3) information about the properties of pharmaceuticals[, wherein said user computer is connected to a communication medium by which said computer] using said user interface, and

c. selectively communicating [communicates] with one or more other computers run respectively by or on behalf of one or more of a group consisting of (a) a Health Maintenance Organization, (b) an insurance company, (c) a drug benefit plan, (d) a pharmacy run by a different organization than the organization running the user computer, (e) a laboratory, and (f) a physician practice.

73. (Amended) The [computerized prescription system of claim 3 in which said user computer is configured to gather] method of claim 72, further comprising the step of gathering information from more than one of said one or more other computers and presents that information to a user [upon request submitted] through said graphical user interface.

74. (Amended) The [computerized prescription system of claim 4 in which said user computer is configured to gather] method of claim 73 further comprising the step of gathering information from more than one of said one or more other computers and [compile] compiling that information into a prescription history for a patient.

75. (Amended) The [computerized prescription system of claim 4, in which said user computer is configured to gather] method of claim 73, further comprising the step of gathering information from more than one of said one or more other computers and [compile] compiling that information into said information about pharmaceuticals.

76. (Amended) The [computerized prescription system of claim 4, in which said user computer is configured to gather] method of claim 73, further comprising the step of gathering information from more than one of said one or more other computers and [compile] compiling that information into said information about the properties of pharmaceuticals.

77. (Amended) The [computerized prescription system of claim 2, in which said graphical user interface permits] method of claim 70, further comprising the step of permitting a user to send a prescription directly to a pharmacy to be filled over said communications medium, using said graphical user interface.

78. (Amended) The [computerized prescription system of claim 1, in which] method of claim 70, further comprising the step of selectively arranging information about

pharmaceuticals [is selectively arranged] in at least two of (1) the order of frequency with which pharmaceuticals are prescribed by a user, (2) in alphabetical order, (3) in order of condition treated and (4) in order of pharmaceuticals prescribed for a particular patient.

79. (Amended) The [computerized prescription system of claim 1, in which] method of claim 70, further comprising the step of arranging information about pharmaceuticals [is arranged by] in order of the body system treated by the pharmaceuticals.

80. (Amended) The [computerized prescription system of claim 1, in which] method of claim 70, further comprising the step of selectively arranging information about pharmaceuticals [is selectively arranged] by drug category.

81. (Amended) The [computerized prescription system of claim 1 in which,] method of claim 70, further comprising the step of when a pharmaceutical is prescribed for a condition, and the pharmaceutical is not the best first line agent for treatment of that condition, [the graphical user interface will suggest] suggesting an alternative pharmaceutical to be prescribed instead.

82. (Amended) The [computerized prescription system of claim 12, in which] method of claim 81, further comprising the step of retrieving guidelines relating to the use of said alternative pharmaceutical [may be retrieved] using said graphical user interface.

83. (Amended) The [computerized prescription system of claim 1, in which] method of claim 70, further comprising the step of said arranging information about a patient's prescription history [is arranged] by condition for which a prescription was written.

84. (Amended) The [computerized prescription system of claim 1] method of claim 70, in which said user computer is a personal digital assistant.

85. (Twice Amended) A computer implemented method of creating a prescription, comprising the steps of:

- a. capturing prescription information using a computer interface of a personal digital assistant;
- b. formatting said prescription information for communications; and
- c. sending said prescription formation to [an offsite] a pharmacy located remotely from a facility at which said prescription information is captured over a communication link to be filled.

86. (Amended) The method of claim [16] 85, in which said prescription information includes the condition to be treated by the prescribed item.

87. (Amended) The method of claim [16] 85, in which said prescription information is selected from a predefined list.

88. (Amended) The method of claim [18] 87, in which said predefined list is arranged in order of frequency of prescription for a specified condition to be treated.

89. (Amended) The method of claim [18] 87, in which said predefined list is arranged in order of cost.

90. (Amended) The method of claim [18] 87, in which said predefined list is arranged in order of therapeutic preference according to drug formulary guidelines.

91. (Twice Amended) A method of compiling a patient record at a location, comprising the steps of:

a. interrogating [offsite] databases located remotely from said location expected to contain information about a patient based on a patient's relationship with the provider of that database; and

b. assembling patient information into a chronologically current version of said patient's medical history.

92. (Amended) The method of claim [22] 91, further comprising the step of discarding said current version of said patient's medical history without creating a file copy.

94. (Thrice Amended) A method of using a computerized prescription system, [comprising:] having

at least one user computer, said user computer having a graphical user interface comprising the steps of:

- a. permitting capture of prescription information and
- b. providing access to all of (1) information about a patient's medical history, (2) information about therapeutic agents and (3) information about individual prescriber activity, wherein the information [is obtained] from only [offsite] databases located remotely from the location of said user computer.

99. (Thrice Amended) A computer program product, comprising:

- a. a memory medium; and
- b. a computer program stored on said memory medium, said computer program containing instructions for capturing prescription information and providing access to all of (1) information about a patient's prescription history, (2) information about pharmaceuticals arranged by medical conditions for which the pharmaceuticals are suitable for treating, and (3) information about the properties of pharmaceuticals, wherein said computer program comprises further instructions to communicate with one or more other computers run respectively by or on behalf of one or more of a group consisting of (a) a Health Maintenance Organization, (b) an insurance company, (c) a drug benefit plan, (d) [an offsite] a pharmacy run by a different organization than the organization running the user computer, (e) a laboratory, and (f) a physician practice.

100. (Thrice Amended) A computer program product, comprising:

a. a memory medium; and

b. a computer program stored on said memory medium, said computer program containing instructions for capturing prescription information using a computer interface of a personal digital assistant, for formatting said prescription information for communications; and sending said prescription formation to [an offsite] a pharmacy located remotely from said personal digital assistant over a communication link to be filled.

101. (Twice Amended) A computer program product, comprising:

a. a memory medium; and

b. a computer program stored on said memory medium, said computer program containing instructions for interrogating [offsite] databases remotely located from a computer running said computer program expected to contain information about a patient based on a patient's relationship with the provider of that database; and for assembling patient information into a chronologically current version of said patient's medical history.

102. (Thrice Amended) A computer program product, comprising:

a. a memory medium; and

b. a computer program stored on said memory medium, said computer program containing instructions for implementing a graphical user interface permitting capture of prescription information and providing access to all of (1) information about a patient's

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medical history, (2) information about therapeutic agents and (3) information about individual prescriber activity, wherein the information is obtained from one or more [offsite] databases located remotely from a computing device running said computer program.

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